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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/566,630	01/31/2006	Noriyuki Sakoh	277513US6PCT	7218
22850	7590	06/27/2008		
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER				
JACOB, AJITH				
ART UNIT		PAPER NUMBER		
2161				
NOTIFICATION DATE		DELIVERY MODE		
06/27/2008		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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### Office Action Summary

**Application No.**

10/566,630

**Applicant(s)**

SAKOH ET AL.

**Examiner**

AJITH JACOB

**Art Unit**

2161

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 May 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3-11 and 13-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-11 and 13-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on November 6, 2007 has been entered.

### ***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-4, 7-10 and 11-19 are directed towards software, *per se*. The claims lack the necessary physical articles or objects to constitute a machine or a manufacture within the meaning of 35 USC 101. They are clearly not a series of steps or acts to be a process nor are they a combination of chemical compounds to be a composition of matter. As such, they fail to fall within a statutory category. They are, at best, functional descriptive material *per se*. Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." Both types of "descriptive material" are nonstatutory when claimed as descriptive material *per se*, 33 F.3d at 1360, 31 USPQ2d at 1759. When functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the

function of the descriptive material to be realized. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994). Merely claiming nonfunctional descriptive material, i.e., abstract ideas, stored on a computer-readable medium, in a computer, or on an electromagnetic carrier signal, does not make it statutory. See *Diehr*, 450 U.S. at 185-86, 209 USPQ at 8 (noting that the claims for an algorithm in *Benson* were unpatentable as abstract ideas because "[t]he sole practical application of the algorithm was in connection with the programming of a general purpose computer.").

3. Claim 1 is a device claim that describes a control device for a display, but does not specify a physical piece of hardware to fulfill the claim, and thus has been rejected.
4. Claims 2-4, 7-10 and 19 does not solve any of the non-statutory deficiencies of claim 1, and thus are rejected for the reasons stated above.
5. Claim 11 is a device claim that describes a control device for a display unit, but does not specify a physical piece of hardware to fulfill the claim, and thus has been rejected.
6. Claims 12-18 does not solve any of the non-statutory deficiencies of claim 11, and thus are rejected for the reasons stated above.

#### ***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1, 3, 5-7, 11, 13, 15 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Odamura et al. (GB 2,360,912 A).

For claim 1, Odamura et al. teaches:

A data display control device comprising: a database storing a plurality of text data with at least a first length [base station receiving multiple data, page 10, lines 13-19]; search means for searching the database for at least one piece of text data with the first length, based on an input search key [client terminal receiving request and transmitting to base station, page 10, lines 26-28]; a display including a display area configured to display text data from the database, the display area having a width [display unit to output data with a range, page 7, lines 20-27]; control means for obtaining partial text data with a second length that is smaller than the first length and corresponding to the width of the display area, out of the at least one piece of text data found by the search means, from the database, and to display the partial text data on the display area [base station divides data into a range that fits the display, page 10, lines 13-19]; and scrolling means for horizontally scrolling display of the partial text data and remaining text data on the display area after receiving a command from a user, the remaining text data being all the text data other than the partial text data, the scrolling means obtaining the remaining text data from the database and automatically horizontally scrolling the remaining text data after the partial text data [scrolling to display data from first to the next, page 12, lines 4-21 and Figure 12].

For claim 3, Odamura et al. teaches:

The data display control device according to claim 1, wherein the control means obtains a text data part, that is larger than the second length and smaller than the first

length, out of the at least one piece of text data found by the search means, with the text data part added to the partial text data, from the database, and to perform horizontal scroll display on the display area [displaying edited second and later pages upon request to the display after the first page is transmitted, page 11, line 29 – page 12, lines 1-3].

Claim 5 is a method of claim 1 and 7. Odamura et al. teaches the limitations of claim 1 and 7 for the reasons stated above and below, respectively.

Claim 6 is a program of claim 1 and 7. Odamura et al. teaches the limitations of claim 1 and 7 for the reasons stated above and below, respectively.

For claim 7, Odamura et al. teaches:

The data display control device according to claim 1, wherein the display area has a height of one line of text data [range limitation to page inherently teaches possibility of one line text, page 7, lines 20-27].

Claim 11 is a unit device of claim 1. Odamura et al. teaches the limitations of claim 1 for the reasons stated above.

Claim 13 is a unit device of claim 3. Odamura et al. teaches the limitations of claim 3 for the reasons stated above.

Claim 15 is a unit device of claim 7. Odamura et al. teaches the limitations of claim 7 for the reasons stated above.

For claim 19, Odamura et al. teaches:

The data display control device according to claim 1, wherein the scrolling means automatically vertically scrolls other pieces of text data after automatically

horizontally scrolling the remaining text data after the partial text data [scrolling function and turning page function, page 12, 4-21 and Figure 12].

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

10. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

11. Claims 4 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Odamura et al. as set forth above against claim 3 above, and in view of Negishi et al. (US 6,504,089 B1).

As per claim 4, Odamura et al. teaches control means displaying data in accordance with the size [page 10, lines 13-19], but does not teach the temporary storage of data in a storage medium before partial display of the data.

Negishi et al. teaches the data of a music piece being stored, and the at least one candidate of the piece information being presented [column 3, lines 51-59].

Odamura et al. (GB 2,360,912 A) and Negishi et al. (US 6,504,089 B1) are analogous art because they are from the same field of endeavor of displaying stored data.

At the time of the invention it would have been obvious to a person of ordinary skill in the art to modify the control unit for display described by Odamura et al. and add a storage unit for temporary storage and partial display as described by Negishi et al.

The motivation for doing so would have been to separate the "essential valuable content" [column 2, line 47] from a stored data to be displayed.

Therefore, it would have been obvious to combine Odamura et al. (GB 2,360,912 A) with Negishi et al. (US 6,504,089 B1) for the benefit of efficiently displaying partial information from stored data.

Claim 14 is a unit device of claim 4. Odamura et al. and Negishi et al. teaches the limitations of claim 4 for the reasons stated above.

12. Claims 8-10 and 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Odamura et al. as set forth above against claim 1 above, and in view of Negishi et al. (US 6,504,089 B1).

As per claims 8-10, Odamura et al. teaches display means displaying data in certain range [page 7, lines 20-27], but does not teach a speaker to output data and title and artist display.



Negishi et al. teaches a speaker to output reproduced music [column 5, lines 49-60], display of title [column 7, lines 47-61] and display of artist name [column 7, lines 47-61].

Odamura et al. (GB 2,360,912 A) and Negishi et al. (US 6,504,089 B1) are analogous art because they are from the same field of endeavor of displaying stored data.

At the time of the invention it would have been obvious to a person of ordinary skill in the art to modify the control unit for display described by Odamura et al. and add a storage unit for temporary storage and partial display as described by Negishi et al.

The motivation for doing so would have been for "the identification of a musical piece" [column 1, lines 25-35].

Therefore, it would have been obvious to combine Odamura et al. (GB 2,360,912 A) with Negishi et al. (US 6,504,089 B1) for the benefit of outputting stored data.

Claim 16 is a unit device of claim 8. Odamura et al. and Negishi et al. teaches the limitations of claim 8 for the reasons stated above.

Claim 17 is a unit device of claim 9. Odamura et al. and Negishi et al. teaches the limitations of claim 9 for the reasons stated above.

Claim 18 is a unit device of claim 10. Odamura et al. and Negishi et al. teaches the limitations of claim 10 for the reasons stated above.

***Response to Arguments***

13. Applicant's arguments filed May 29, 2008 have been fully considered but they are not persuasive. The examiner respectfully traverses applicant's argument.

The amendment to claim 6 has overcome the 101 rejection for that particular independent claim. The addition of a display and scrolling means to claim 1 does not overcome the need of a hardware to make the device tangible. A display can be created in software form, and thus the 101 rejection for claim 1 and its dependent claims 3-4, 7-10 and 19 are maintained. Device claims 11 and 13-18 also do not overcome the 101 rejections due to lack of hardware.

Applicant argues that Odamura et al. (GB 2,360,912 A) does not teach horizontal scrolling display of the partial text data and the remaining text data on the display area after receiving a command from a user, the remaining text data being all the text data other than the partial text data, the scrolling means obtaining the remaining text data from the database and automatically horizontally scrolling the remaining text data after the partial text data. Odamura et al. clearly teaches the ability to display data larger than a set length [page 12, lines 4-21] and the ability to scroll the data if it is longer than available display area and turning pages [Figure 12]. Figure 12 clearly states the availability of a scrolling function, which could either be vertical or horizontal.

In light of the forgoing arguments, the 35 U.S.C. 102 and 103 rejections are hereby sustained.

***Conclusion***

14. The Examiner requests, in response to this Office action, that support be shown for language added to any original claims on amendment and any new claims. That is,

indicate support for newly added claim language by specifically pointing to page(s) and line no(s) in the specification and/or drawing figure(s). This will assist the Examiner in prosecuting the application.

When responding to this Office action, Applicant is advised to clearly point out the patentable novelty which he or she thinks the claims present, in view of the state of the art disclosed by the references cited or the objections made. He or she must also show how the amendments avoid such references or objections See 37 CFR 1.111(c).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ajith Jacob whose telephone number is 571-270-1763. The examiner can normally be reached on M-F 7:30-5:00 EST, Every other Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Apu Mofiz can be reached on 571-272-4080. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Art Unit: 2161

/B. S./

Examiner, Art Unit 2161

6/19/2008

/A.J./

Patent Examiner

/Apu M Mofiz/

Supervisory Patent Examiner, Art Unit 2161